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OFFICE OF PETITIONS

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#11

DOCKET NO. SPC-5069CNT6

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Roger A. de la Torre Confirmation No.: 3761  
Serial No.: 10/004,468 Examiner: Glenn K. Dawson  
Filed: October 23, 2001  
Title: **LAPROSCOPIC ACCESS PORT FOR SURGICAL  
INSTRUMENTS OR THE HAND**

I hereby certify that this correspondence is being deposited with the  
United States Postal Service as first class mail in an envelope addressed  
to: Assistant Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

October 31, 2003  
(Date of Deposit)

Kimberly M. Moses  
Name of person signing the Certificate

*Kimberly M. Moses*  
(Signature)

October 31, 2003  
(Date of Signature)

Attention: Office of Petitions  
**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Fax: 1-703-308-6916

**PETITION FOR REVIVAL OF AN APPLICATION  
FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR THE REVIVAL OF  
THE ABOVE-IDENTIFIED APPLICATION**

- Note:** A grantable petition required the following items:
- (1) Petition Fee;
  - (2) Reply and/or issue fee;
  - (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
  - (4) Statement that the entire delay was unintentional.

11/04/2003 AWONDAF1 00000090 100750 10004468

01 FC:1453 1330.00 DA

1. Petition fee

☐ Small entity- fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity-fee \$ 1,330.00 (37 CFR 1.17(m))

2. Rely and/or fee:

a. The reply and /or fee to the above-noted Office action in the in the of  
Three (3) month extension of time. (identify type of reply):

☐ has been filed previously on \_\_\_\_\_.

☒ charge the petition fee of \$950.00 to Account **10-0750/SPC-069CNT6/DLG** and for any additional fees required. This form is submitted as one original and two copies.

b. The Issue of \$ \_\_\_\_\_.

☐ has been paid previously on \_\_\_\_\_.

☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee:

☒ Since the utility/patent application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of  
\$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity)  
disclaiming the required period of time is enclosed herewith.

4. Statement: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [Note: The United States Patent and trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.00003(c), subsections (III) (C) and (D))].

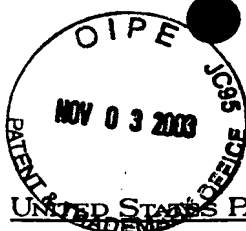
5. Fee payment:

- ☒ Charge the petition fee of \$1,330.00 to Account **10-0750 /SPC-5069CNT6/DLG** and for any additional fee required. A duplicate of this petition is attached.
- ☐ A check in the sum of \$\_\_\_\_\_ is attached.
- ☒ Charge Account **10-0750 /SPC-5069CNT6/DLG** for any additional fee required.



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Attorney for Applicant(s)

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Date: October 31,2003



UNITED STATES PATENT AND TRADEMARK OFFICE

*D. Garner*  
*DK*

0201-000

SPC506945ACNT

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/004,468      | 10/23/2001  | Roger A. de la Torre | 00167-293004        | 6548             |

7590 03/24/2003

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OCT 07 2003

DEAN L. GARNER

MAR 31 2003

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EXAMINER

DAWSON, GLENN K

ART UNIT PAPER NUMBER

3761

DATE MAILED: 03/24/2003

OFFICE OF PETITIONS

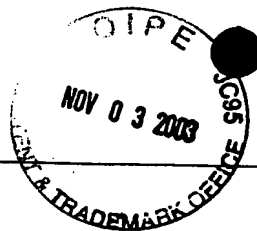
Please find below and/or attached an Office communication concerning this application or proceeding.

*Final Appeal*  
*Notice of*  
*appeal*  
*6/24/03*

COPY FORWARDED TO ASSIGNEE

DATE: 10/2/03  
SIGNED: CEIL SURMAN

**Office Action Summary**



Application No.

10/004,468

Applicant(s)

DE LA TORRE ET AL.

Examiner

Glenn K Dawson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-36, 40, 42-50 and 53 is/are rejected.
- 7) ☒ Claim(s) 37-39, 41, 51 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 34-36,40,42,43,45-47 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Leahy-5640977.

Leahy discloses in fig. 16-19 an embodiment having a first member 200 having a portion for attachment to the patient (202) and a first coupling 251 and a passageway therethrough; a second member 253 having a second coupling 252, a flexible portion 253 configured to extend into the passageway. The two couplings seal together when removably attached together. The length of part 253 is longer than part 204.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 48,49 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy-'977.

Leahy discloses the invention as claimed with the exception of the portion of the first member can be inserted into the incision. The embodiment of Leahy's shown in fig. 19 shows an embodiment wherein a portion 262 extends into the incision. It would have been obvious to have used this type of patient interface instead of, or in addition to, the adhesive ring as shown in fig. 18, as it would have provided the device with additional

support while providing protection for the tissue around the incision so that a hand or instrument inserted through the incision would not directly contact the tissues.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34,35,44 and 46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6024736. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application are merely broader in scope than dependent claims of the patent.

Claims 34,35 and 42-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6319246. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the application are merely broader in scope than dependent claims of the patent.



***Allowable Subject Matter***

Claims 37-39,41,51 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn K Dawson whose telephone number is 703-308-4304. The examiner can normally be reached on M-Th 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

*GKD*  
Glenn K Dawson  
Primary Examiner  
Art Unit 3761

gkd  
March 18, 2003



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**Notice of References Cited**

Application/Control No.

10/004,468

Applicant(s)/Patent Under  
Reexamination  
DE LA TORRE ET AL.

Examiner

Glenn K Dawson

Art Unit

3761

Page 1 of 1

**U.S. PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Name                | Classification |
|---|---|--|-----------------|---------------------|----------------|
|   | A | US-5423848                                       | 06-1995         | Washizuka, et al.   | 606/185        |
|   | B | US-5640977                                       | 06-1997         | Leahy, et al.       | 128/897        |
|   | C | US-6024736                                       | 02-2000         | De La Torre, et al. | 606/1          |
|   | D | US-6319246                                       | 11-2001         | De La Torre, et al. | 606/1          |
|   | E | US-  |                 |                     |                |
|   | F | US-  |                 |                     |                |
|   | G | US-  |                 |                     |                |
|   | H | US-  |                 |                     |                |
|   | I | US-  |                 |                     |                |
|   | J | US-  |                 |                     |                |
|   | K | US-  |                 |                     |                |
|   | L | US-  |                 |                     |                |
|   | M | US-  |                 |                     |                |

**FOREIGN PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Country | Name | Classification |
|---|---|--|-----------------|---------|------|----------------|
|   | N |  |                 |         |      |                |
|   | O |  |                 |         |      |                |
|   | P |  |                 |         |      |                |
|   | Q |  |                 |         |      |                |
|   | R |  |                 |         |      |                |
|   | S |  |                 |         |      |                |
|   | T |  |                 |         |      |                |

**NON-PATENT DOCUMENTS**

| * |   | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
|   | U |   |
|   | V |   |
|   | W |   |
|   | X |   |

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.